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09/915,719

07/25/2001

James A. Parker

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03/18/2008

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT

PAPER NUMBER

2144

NOTIFICATION DATE

DELIVERY MODE

03/18/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|---------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/915,719  | <b>Applicant(s)</b><br>PARKER, JAMES A. |  |
|                              | <b>Examiner</b><br>JOSEPH R. MANIWANG | <b>Art Unit</b><br>2144                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25, 29-33, 37, 38, 44-52 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) 29-33, 37, 38 and 49-52 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25, 44-48, 55 and 56 is/are allowed.
- 6) ☒ Claim(s) 57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 57 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 57 recites the limitation "the memory of the first computer". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 57 and 58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Independent claim 57 is directed to "An apparatus comprising: (1) a first computer coupled through the Internet computer network to a multitude of second computers; and (2) a data stream in the memory of the first computer, the data stream encoding data arranged in a plurality of data frames and comprising: (a) header data...; (b) data...; (c) data...; (d) data...; and (e) data...". The claim defines non-functional

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descriptive material on a memory. Nonfunctional descriptive material includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Limitations (2) and (a)-(e) (i.e., “a data stream”, “data”, “frames”) are clearly intended to cover a “mere arrangement of data” and thus constitutes nonfunctional descriptive material. Accordingly, there is no practical application making available a useful, concrete, and tangible result to realize any usefulness. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer, or on an electromagnetic carrier signal (i.e., “in the memory of the first computer”), it is not statutory since no requisite functionality is present to satisfy the practical application requirement (see MPEP 2106.01). Although the invention claims a computer and memory, the invention fails to recite a proper data structure within such computer-readable mediums as the claimed “data stream” fails to define structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized (see MPEP 2106.01, section I).

### ***Allowable Subject Matter***

7. Claims 1-25, 44-48, 55 and 56 are allowed. The Examiner’s reasons for allowance are stated in a previous action.

### ***Response to Arguments***

8. Applicant's arguments filed 08/30/07 have been fully considered but they are not persuasive.

9. Regarding claims 57 and 58 rejected under 35 U.S.C. 101, Applicant argues in substance that:

10. A. "the claimed invention is to a configured computer", and "That fact alone suffices to satisfy Section 101". To this point, Examiner submits that the recitation of a computer alone is not sufficient in satisfying considerations under 35 U.S.C. 101. The claim, taken as a whole, is directed simply to data on a computer. Merely claiming data (i.e., an abstract idea) stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. Such a result would exalt form over substance. Semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is (see MPEP 2106.01). As such, the whole of claim 57 is clearly directed to such data (i.e., nonfunctional descriptive material) stored on a computer, and is therefore non-statutory.

11. B. "a 'data stream' residing 'in the memory of a first computer'...is a Beauregard claim". Applicant's assertion is that the claim, like a "Beauregard claim", "consists of 'indicia of instructions' residing on a 'data storage medium'", where the claimed "data stream" resides "in the memory of a first computer". However, Examiner notes that a statutory form of data embodied on a computer readable medium or the like necessitates that such data be directed to functional descriptive material. Functional descriptive material consists of data structures and computer programs which impart

functionality when employed as a computer component. It is noted that any descriptive material (i.e., data), per se, is nonstatutory. However, even when embodied on a computer readable medium or the like, such an embodiment is statutory only when the descriptive material becomes structurally and functionally interrelated to the medium it is recorded on, permitting the function of the descriptive material to be realized. In this case, even when the claimed "data stream" is embodied "in the memory of a first computer", the embodiment does not cause the data stream to impart functionality as a computer component. In short, the descriptive material claimed is nonfunctional descriptive material, and cannot be considered statutory as functional descriptive material embodied on a computer readable medium.

12. C. "Claim 57 defines an invention that has practical application, produces concrete, and tangible results, and is useful and functional". Applicant states that the assertion that the claimed data/elements do not impart any functionality whatsoever on any implied destination computer" is squarely incorrect. However, Examiner submits that this assertion applies to claim 57, as does further reasoning regarding the lack of functionality within the claim language.

13. Applicant asserts that the claimed invention "has expressly stated functionality when the data stored in the machine is applied to a computer" (Remarks, p. 16, item 4). This outlines the first problem regarding 101 considerations against this claim. Such a provision (i.e., a computer to which the signal/data stream is applied) is not recited in the claims. Instead, as detailed above, the claims are directed solely to a "data stream in the memory of the first computer". That is, the claimed "data stream" is never actually

applied to any computer, explicit or implied. Therefore, the claimed "data stream" is not functioning and is not permitted by the computer it is embodied in to realize its intended functionality, if any. Instead, the data is merely "in the memory", and is nonfunctional.

14. Secondly, while it may be argued by Applicant that the claimed "data stream in the memory of the first computer" is likened to a statutory medium containing computer instructions, it is noted that the claimed data is not a proper data structure. Examiner notes that data structures, such as the claimed "data stream" comprising "data" and "frames", not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. Accordingly, even while it may be claimed as embodied in a computer readable media (i.e., "in the memory of the first computer"), the data structure does not define structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized. Although Applicant asserts that the claim language relating to the data structure of limitations (a)-(e) explicitly recite functionality, an analysis of the language shows that any recited functionality is to be performed by the data itself, and not to cause functional change in the computer as required by a statutory data structure:

"(a) header data that...identifies...;

"(b) data...encoding...;

"(c) data...that...has the function of identifying...;

"(d) data...that...has the function of identifying...;

"(e) data...that...has the function of identifying..."

Clearly, the above claimed data elements within such a memory do not impart any functionality whatsoever on any implied computer or the like, and instead are directed to “identifying” a particular computer or data representing a body of an e-mail, but itself does not cause a computer to perform the identification. These elements are nothing more than a mere arrangement of data, which is nonfunctional descriptive material and therefore nonstatutory as it fails to meet the practical application requirement.

Regardless of the embodiment in which they are claimed, the claimed data arrangement cannot be statutory, as merely claiming such non-functional descriptive material stored in a computer-readable medium, in a computer, or on a signal would exalt form over substance.

15. Lastly, although the claim elements (a)-(e) recite that each data element somehow independently “perform” identifying, etc., the claim language recites that such limitations take place only “when read by a computer” or “when applied to the destination computer”. Examiner notes that such a recitation is merely intended use, and that such limitations accordingly are not claimed as causing functional change in any computer explicitly/implicitly recited in the claim.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH R. MANIWANG whose telephone number is (571)272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM

/William C. Vaughn, Jr./  
Supervisory Patent Examiner, Art Unit 2144